

REMARKS

Claims 1-8, 13-21 and 23-26 were examined and reported in the Office Action. Claims 1-8, 13-21 and 23-26 are rejected. Claims 1, 3-5, 7, 13, 17 and 24-25 are amended. Claims 1-8, 13-21, and 23-26 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 103(a)

A. It is asserted in the Office Action that claims 1-6, 8 and 13-16 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 6,114,739 issued to Theil et al. ("Theil") in view of U.S. Patent Application No. 5,600,486 issued to Gal et al ("Gal") in view of Kato et al (US 2002/0030890). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." "All words in a claim must be considered in judging the patentability of that claim against the prior art." (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

It is asserted in the Office Action that "the prior art does not teach or fairly suggest a protective layer as claimed which is made of a sol-gel material." (Office Action, page 9, section 7). Applicant has amended claims 1 and 5 to include the limitations of "the protective layer is of a sol gel material," and claim 13 to include the limitations of "a protective layer of a sol gel material."

Therefore, neither Theil, Gal, Kato, nor the combination of the three, teach, disclose or suggest the limitations contained in Applicant's amended claims 1, 5 and 13, as listed above. Since neither Theil, Gal, Kato, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's amended claims 1, 5 and 13, Applicant's amended claims 1, 5 and 13 are not obvious over Theil in view of Gal and Kato since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 1, 5 and 13, namely claims 2-4, 6 and 8, and 14-16, respectively, would also not be obvious over Theil in view of Gal and Kato for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-6, 8 and 13-16 are respectfully requested.

B. It is asserted in the Office Action that claims 17-21, 23, 24 and 26 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Theil in view of U.S. Patent Application No. 5,760,834 issued to Rostoker et al ("Rostoker"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

As mentioned above, it is asserted in the Office Action that "the prior art does not teach or fairly suggest a protective layer as claimed which is made of a sol-gel material." (Office Action, page 9, section 7). Applicant has amended claim 17 to include the limitations of "the protective layer is of a sol gel material."

Therefore, neither Theil, Rostoker, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's amended claim 17, as listed above. Since neither Theil, Rostoker, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 17, Applicant's amended claim 17 is not obvious over Theil in view of Rostoker since a *prima facie* case of obviousness has not

been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 17, namely claims 18-21, 23-24 and 26, would also not be obvious over Theil in view of Rostoker for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 17-21, 23, 24 and 26 are respectfully requested.

II. Allowable Subject Matter

Applicant notes with appreciation the Examiner's assertion that claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has amended claims 1, 5, 13 and 17 to include the allowable limitations as asserted in the Office Action.

Applicant respectfully asserts that claims 1-8, 13-21 and 23-26, as it now stands, are allowable for the reasons given above.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-8, 13-21 and 23-26 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on August 11, 2005.


Jean Svoboda